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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,216	04/16/2004	Leonid Rappoport	PMR-105	1176
30869	7590	03/23/2005	EXAMINER	
LUMEN INTELLECTUAL PROPERTY SERVICES, INC. 2345 YALE STREET, 2ND FLOOR PALO ALTO, CA 94306			ROBERTSON, JEFFREY	
			ART UNIT	PAPER NUMBER

1712

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/826,216	RAPPOPORT ET AL.	
	Examiner	Art Unit	
	Jeffrey B. Robertson	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-10 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 is/are allowed.
- 6) ☒ Claim(s) 1-3,6-8,10,20 and 22 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0904</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 22 is objected to because of the following informalities: For claim 22, the examiner is unsure of what is being claimed in claim 22. This claim has been interpreted as a polymer of the compound of claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 6-8, 10, 20, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Weihe (U.S. Patent No. 2,221,418).

For claims 1-3 and 6, Weihe teaches that dithiodibutylene glycol is reacted with succinic anhydride, where the product that is formed is an insoluble balsam. Page 1, lines 45-54. Here, $n=2$, R and R¹ contain 4 carbon atoms each, and A is a residue of succinic anhydride. For claims 7, 8, and 22, it appears that the product produced is a polymer that falls within the definition of structure (a) in claim 7. For claim 20, Weihe teaches that dithiodiethyleneglycol is used on page 1, lines 24-25. Regarding claim 10, it is the examiner's position that the products taught by Weihe would inherently satisfy the limitations for this claim. Specifically, termination of the products set forth by Weihe would either be through a residue of dithiodibutylene glycol or succinic anhydride. This

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means that R^2 and R^3 are divalent radicals of either $-C(O)-(CH_2)_2-$ or $-(CH_2)_4S_2(CH_2)_4-$ and W and W^1 are hydroxy or carboxyl. Since R^2 and R^3 are not limited to organic radicals without substitution, it is the examiner's position that the limitations of claim 10 are met.

4. Claims 1-3, 6-8, 10, 20, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. (U.S. Patent No. 5,407,972).

For claims 1-3 and 6, Smith teaches that dithiodiglycol is reacted with succinic anhydride, where the product that is formed is a resin. Col. 8, Example I. Here, $n=2$, R and R^1 contain 2 carbon atoms each, and A is a residue of succinic anhydride. For claims 7, 8, 20, and 22, it appears that the product produced is a polymer that falls within the definition of structure (a) in claim 7. Regarding claim 10, it is the examiner's position that the products taught by Smith would inherently satisfy the limitations for this claim. Specifically, termination of the products set forth by Smith would either be through a residue of dithiodibutylene glycol or succinic anhydride. This means that R^2 and R^3 are divalent radicals of either $-C(O)-(CH_2)_2-$ or $-(CH_2)_2S_2(CH_2)_2-$ and W and W^1 are hydroxy or carboxyl. Since R^2 and R^3 are not limited to organic radicals without substitution, it is the examiner's position that the limitations of claim 10 are met.

Allowable Subject Matter

5. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claim 21 is allowed.

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7. The following is a statement of reasons for the indication of allowable subject matter: For claims 9 and 21, Weihe is the closest prior art. This reference fails to teach the presence of a fatty acid dimer. For claim 21, there is no teaching or suggestion for the addition of dimethylolpropionic acid as a reactant to form the reaction product claimed therein.

Conclusion

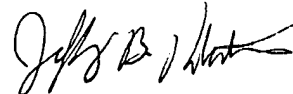
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kranzlein et al. (U.S. Patent No. 1,422,869) and Beekman et al. (US 2001/0036987 A1) are cited for general interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR